

REMARKS

I. Introduction

Claims 1-11 are currently pending in the present application. Claims 1, 4, and 7 are independent. All pending claims stand rejected. In particular:

(A) claims 1-6 stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by U.S. Patent Application Publication No. 2002/0116262 (hereinafter “Mitchell”); and

(B) claims 7-11 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of U.S. Patent Application Publication No. 2001/0046851 (hereinafter “Yamaguchi”).

Upon entry of this amendment, which is respectfully requested, claims 1-2 and 7-8 will be amended *solely* for clarification of certain embodiments (and not in direct response to any art of record), claims 4-6 will be cancelled without prejudice or disclaimer, and new claims 12-21 will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. The Examiner’s Rejections

A. 35 U.S.C. §102(b) – Mitchell

Claims 1-6 stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by Mitchell. Claims 4-6 are cancelled herein, rendering this ground for rejection *moot* with respect thereto. Applicants hereby expressly reserve the right to pursue any such cancelled claims in one or more continuing applications. Applicants respectfully traverse this ground for rejection with respect to remaining claims 1-3 as follows.

1. The cited reference fails to teach or suggest: transmitting a promotional message...which...includes a code that is redeemable for a benefit at the vending machine

Applicants respectfully assert that Mitchell fails to teach or suggest limitations of claims 1-3. For example, Mitchell fails to teach or suggest *transmitting a promotional message...which...includes a code that is redeemable for a benefit at the vending machine*.

The Examiner is correct that Mitchell describes transmitting messages to e-mail addresses of customers. Those messages are described, in Mitchell, as including a password and a link to a rewards website. The customer in Mitchell can utilize the password to access the website and receive benefits. This is **simply not equivalent to** transmission of a code that is redeemable at the vending machine, as claimed. Nowhere does Mitchell describe such a concept, much less provide adequate written description thereof.

Accordingly, at least because Mitchell fails to teach or suggest *transmitting a promotional message...which...includes a code that is redeemable for a benefit at the vending machine*, Mitchell fails to anticipate claims 1-3.

B. 35 U.S.C. §103(a) – Mitchell, Yamaguchi

Claims 7-11 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of Yamaguchi. Applicants traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to show how every element of the claims is taught or suggested by the cited references and the Examiner has entirely failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth a valid reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as

suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) **The Examiner has filed to provide evidence that the references teach or suggest:** *determining at least one rule defining restrictions on when a message may be sent to at least one of the email addresses*

Applicants respectfully assert that the Examiner has failed to provide evidence that Mitchell and Yamaguchi, alone or in combination, teach or suggest limitations of claims 7-11. For example, the Examiner has failed to provide evidence that Mitchell and Yamaguchi teach or suggest *determining at least one rule defining restrictions on when a message may be sent to at least one of the email addresses*.

The Examiner relies on paragraph [0161] of Yamaguchi as allegedly providing evidence of a teaching or suggestion of the above-quoted limitation. Office Action, pg. 4, lines 4-10.

Applicants have reviewed the cited portions of Yamaguchi and respectfully note that the cited portion of Yamaguchi describes that an e-mail may be sent from a vending machine regularly or in time of error. In other words, Yamaguchi describes *scheduling* e-mail transmission.

In full contrast to *scheduling* e-mail transmission, the above-quoted claimed limitation describes a **restriction** on when an e-mail may be sent. This is the opposite of scheduling.

There is no evidence of record that Mitchell is capable of making up for this deficiency of Yamaguchi.

Accordingly, at least because the Examiner has failed to provide evidence that Mitchell and Yamaguchi teach or suggest *determining at least one rule defining restrictions on when a message may be sent to at least one of the email addresses*, the Examiner has failed to provide evidence setting forth a *prima facie* case of obviousness for any of claims 7-11.

Applicants therefore respectfully request that this §103(a) ground for rejection of claims 7-11 be **withdrawn**.

b) No Reason to Modify is Evident

Even if the Examiner had provided adequate evidence that the cited references taught or suggested each limitation of claims 7-11 (which Applicants maintain is not the case), the Examiner has failed to establish a *prima facie* case for obviousness for any of claims 7-11, at least because the Examiner has provided no valid argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

Accordingly, at least because the Examiner has (i) failed to show how every limitation of claims 7-11 is taught or suggested, (ii) failed to provide a proper reason to combine and/or modify the cited references, and (iii) failed to support any reason to combine and/or modify by evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims 7-11.

Applicants therefore respectfully request that these §103(a) rejections of claims 7-11 be **withdrawn**.

c) No Factual Inquiries Resolved

Applicants also respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (e.g., secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved any of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been

obvious to combine Mitchell and Yamaguchi to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **7-11** should therefore be **withdrawn**.

III. New Claims

New claims **12-21** are believed to be patentable over the cited references at least as described herein. Further, after reviewing the cited references, Applicants believe that none of the cited references, alone or in combination, teach, suggest, or render obvious at least:

- (i) *wherein the benefit comprises a free unit of product dispensed by the vending machine upon input of the code into an interface of the vending machine* (claim **12**);
- (ii) *wherein the representative comprises a representative of a company associated with the location, wherein the set of e-mail addresses comprises a set of e-mail addresses for employees of the company, and wherein the at least one rule is established by the company* (claims **13-14**);
- (iii) *wherein at least a portion of the content of the message that promotes the vending machine comprises content defined by at least one of (i) the company, and (ii) one or more of the employees of the company* (claim **14**);
- (iv) *wherein the content of the message that promotes the vending machine comprises an indication of a code that is operable, upon being input into the vending machine, to cause the vending machine to dispense a discounted unit of a product* (claim **15**);
- (v) *wherein the content of the message that promotes the vending machine comprises an indication that a unit of beverage and a unit of snack may be purchased at the vending machine for one dollar* (claim **16**);
- (vi) *wherein the sending of the message via email transmission to each of the set of email addresses is conducted in response to a triggering of one or more sales thresholds at the vending machine* (claim **17**);

(vii) wherein the sending of the message via email transmission to each of the set of email addresses is conducted in response to an inventory level of a product in the vending machine (claim 18);

(viii) receiving, via the interface and after the causing of the transmission of the promotional message, an indication of the code, verifying the code, and/or providing, in response to the receiving of the code and in the case that the code is verified successfully, the benefit (claim 20);

(ix) wherein the benefit comprises one or more of (i) gasoline, (ii) an electronic download, (iii) internet access, and (iv) clothes washing services (claim 21);

IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Office Action does not imply agreement with those comments.

If there remain any questions regarding the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number (203) 438-6867 or via e-mail at cfincham@finchamdowns.com, upon the Examiner's convenience.

V. Fees and Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Applicants' Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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